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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 501,033	02 09 2000	Leonard E. Mess	11675 168.1	3325

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EXAMINER

NGUYEN, VINH P

ART UNIT PAPER NUMBER

2829

DATE MAILED: 04 08 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/501,033

Applicant(s)

MESS, LEONARD E.

Examiner

VINH P NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-33 and 35-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-33 and 35-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 24 January 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15, 16 6) ☐ Other:

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,6,9-10,16,19,32,35,42,47,52,57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3,5,10 and 20 of a copending application SN# 09/501,025. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because the limitation of claims 1-2 and 4 of the copending application SN# 09/521898 encompass the limitations of the instant claims 1 and 4-5.

3. Claims 1-5,7,9,12-15,17, 19-21,28-31,33, 35,38-40,42-44,46-49,51-54,56-59,61 (are rejected under 35 U.S.C. 102(b) as being anticipated by Hembree et al (Pat # 5,424,652).

As to claims 1-5,7,9,12-13,15,17,19,22,28-30,33,35,38-40,42-44,46-49,51-54,56-59 and 61, Hembree et al disclose an apparatus for testing a semiconductive device (24) having an interposer (14) with a ceramic substrate (14A) with an outmost surface and being configured for receiving thereon the semiconductive device such that the device lies at least in part of the outermost surface and is unimbedded into the substrate (14),electrical conductors (14B) on the substrate (14) with receiving ends connected to the electrical leads (20) of the semiconductive device (24) and with terminal ends (opposite ends of the receiving ends) connected to a testing apparatus. As to claims 14, 31, Hembree et al also disclose a resilient metal clip (34) for holding the interposer (14) stationary relative to the semiconductive device (24) and for biasing the receiving end of the conductor to the electrical leads (20)of the device (24). As to claims 20-21, it appears that the substrate comprises a substantially planar sheet and a substantially homogenous material.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6,10-11,16,21,24-27,32,36-37 are rejected under 35 U.S.C. 103(a) as being  
1. unpatentable over Hembree et al (Pat # 5,424,652) in view of Pryor et al (Pat # 4,712,161) and Long et al (Pat # 5,621,333) and and Hirano et al (Pat # 5,625,298).


Hembree et al disclose an apparatus for testing a semiconductive device (24) as mentioned in previous paragraph. As to claim 10, the material for the connector composed of copper and alloys would have been an obvious design choice since the criticality of this material has not been established by Applicants. As to claims 24-25, 36-37, Pryor et al teach that the material for the ceramic substrate such as Alumina, glass or boron nitrides are well known in the art. It would have been well known in the art to make the ceramic substrate of Hembree et al using the material of Pryor et al. As to claims 26-27, Long et al teach that it would have been well known for one of ordinary skill in the art to provide an insulated layer (20) on top of a

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conductor (22). It would have been obvious for one of ordinary skill in the art to provide an insulated layer on the conductors of Hembree et al as taught by Long et al so that it can be used for preventing the conductors from making contact with other conductors or for heat dissipation. As to claims 6, 11, 16 and 32, it would have been obvious for one of ordinary skill in the art to provide a coating of an electrically insulating material/adhesive on the connector as taught by Long et al so that it is isolated from the conductors on the substrate and short circuit is prevented. Furthermore, it would have been obvious for one of ordinary skill in the art to consider that the insulating layer would be qualified as an adhesive layer since it has equivalent function as the one in the instant application. As to claims 8, 18, 23, 41, 45, 50, 55, 60, Hirano et al teach that it would have been well known to have receiving end disposed within a recess in the substrate. It would have been obvious for one of ordinary skill in the art to have the receiving ends of Hembree et al disposed in the recess as taught by Hirano et al so that the pressure on the semiconductive device pads is reduced so that the pads would not be damaged during testing.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINH P. NGUYEN whose telephone number is (703) 305-4914

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4900.

  
**VINH P. NGUYEN**  
**PRIMARY EXAMINER**  
**ART UNIT 2829**